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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,002	03/15/2001	Robert Stanley Arling	10010131-1	4587
24737	7590	06/01/2006	EXAMINER	
PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510			BLECK, CAROLYN M	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/808,002

Applicant(s)

ARLING ET AL.

Examiner

Carolyn M. Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed on 16 March 2006.

Claims 1-23 are pending. Claims 1 and 23 have been amended.

### ***Claim Objections***

2. Claim 23 is objected to under 37 CFR 1.75(c) as being in improper form because it is a multiple dependent claim. See MPEP § 608.01(n). The Examiner is unable to determine the scope of the claims as presently written. The Examiner suggests rewriting claim 23 to explicitly state the computer readable medium including a set of computer instructions for performing the method.

### ***Claim Rejections - 35 USC § 112***

3. The rejection of claim 22 under 35 U.S.C. 112, second paragraph, is hereby withdrawn.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-7 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 has been amended to recite "wherein the means for providing and the means for inserting comprise a computer readable medium downloaded for processing by a general purpose computer, a personal computer, or a specialized report generator." It is unclear how a computer readable medium is downloaded. The Examiner was unable to find a specific definition for a computer readable medium within the specification as originally filed. Thus, the Examiner has interpreted a computer readable medium to consist of a physical material, such as a disk, used for storing computer based information. It is unclear how a physical material is downloaded for processing by a computer. Appropriate clarification is requested.

For purposes of applying prior art, this newly added limitation is being interpreted as computer instructions that are downloaded to the computer readable medium for processing by a computer.

Similar analysis is applied to claim 23.

Claims 2-7 incorporate the deficiencies of claim 1 through dependency, and are therefore rejected for the same reason.

### ***Claim Rejections - 35 USC § 101***

6. Claims 1-7 and 23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Under the statute, the claimed invention must fall into one of the four recognized statutory classes on invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter. The rejection of claims 1-7 is maintained. It is still unclear to the

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Examiner what statutory class of invention claim 1 is directed towards. It is not clear if the claim is directed towards an apparatus, process, or an article of manufacture.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-2, 4-9, 11-14, 15-16, and 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Background of the Invention (pages 1-2 of Applicant's specification) in view of Coli et al. (6,018,713).

(A) Claim 1 has been amended to recite "wherein the means for providing and the means for inserting comprise a computer readable medium downloaded for processing by a general purpose computer, a personal computer, or a specialized report generator." Claim 23 has been amended to recite computer instructions stored on a medium downloaded for processing by a general purpose computer to carry out the method.... Coli discloses the software environment further including a data management, storage, and retrieval application that organizes the information exchanged between hospitals, laboratories and insurance carriers, wherein this information is organized and stored within the environment of the operating system on one or more mass storage devices, wherein the software architecture underlying the

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particular preferred embodiment is based upon the hypertext conventions of the World Wide Web, wherein the computers can download hypertext pages (Fig. 1, col. 9 line 4 to col. 10 line 18).

(B) Claims 2, 4-9, 11-14, 15-16, and 18-22 have not been amended and are rejected for the same reasons given in the prior Office Action.

9. Claims 3, 10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Background of the Invention (pages 1-2 of Applicant's specification) in view of Coli et al. (6,018,713) as applied to claims 1, 8, and 15, and further in view of Stoodley (6,611,846).

(A) Claims 3, 10, and 17 have not been amended and are rejected for the same reasons given in the prior Office Action.

### ***Response to Arguments***

10. Applicant's arguments filed 16 March 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear in the response filed 16 March 2006.

(A) At page 10 of the response filed on 16 March 2006, Applicant argues that Coli fails to teach or suggest a report generator for automatically and electronically generating a

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computer-readable medical report that has means for automatically inserting data in a predetermined field. In response, the Examiner respectfully submits that Applicant's Background of the Invention clearly teaches that it is well known to automatically inserting a measurement corresponding to the selected medical condition when the medical report is generated (see pg. 2, par. 6 of specification). The Examiner relied on Coli to teach automatically inserting data in a predetermined field. Coli teaches a plurality of test results obtained through a plurality of types of tests used to make a diagnosis, where the test results are organized in a standardized format in which the test result values are arranged in predetermined fields (Fig. 11-13, 18, 20, col. 13 line 43 to col. 14 line 67), wherein the test result values as shown in Fig. 18 and 20 are placed in a field associated with that type of test used to make a particular patient diagnosis (reads on "fields representative of a plurality of medical conditions") (col. 3 lines 43-52), wherein a graphically user interface for data input, wherein the reports of test results are generated using software running on client and server computers (see Fig. 11, col. 9 lines 4-60).

Applicant has not pointed out why the teachings of Applicant's Background of the Invention in combination with Coli fail to teach Applicant's claimed invention. Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant

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has failed to specifically point out HOW the language of the claims patentably distinguishes them from the applied references. Also, arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

Further, Applicant argues that based on Applicant's Background of the Invention, the prior art fails to teach or suggest a means for automatically changing the free text portion of the report. The Examiner respectfully submits that the features upon which applicant relies (i.e., see paragraph 7, page 1 of Applicant's specification) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant also states that Applicant's Background of the Invention is not proper prior art. However, Applicant's provides no explanation for why the Background of the Invention is not proper prior art.

(B) At pages 11-12 of the response filed on 16 March 2006, Applicant argues that Stoodley fails to teach automatically inserting data of a medically relevant characteristic into a predetermined field upon generating a medical report. The Examiner respectfully submits that Stoodley was not relied on for this feature.

### **Conclusion**



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11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**13. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

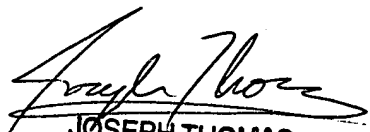
(571) 273-8300	[Official communications]
(571) 273-8300	[After Final communications labeled "Box AF"]
(571) 273-6767	[Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

CB

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May 18, 2006

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER